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10/533,169	04/17/2006	Takeaki Saiki	71051-008	9218
27305 7590 11/09/2009 HOWARD & HOWARD ATTORNEYS PLLC 450 West Fourth Street Royal Oak, MI 48067				
EXAMINER				
DOLLINGER, MICHAEL M				
ART UNIT		PAPER NUMBER		
1796				
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11/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/533,169

**Applicant(s)**

SAIKI ET AL.

**Examiner**

MIKE DOLLINGER

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/29/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

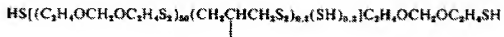
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ely (US 3,925,331).
2. Ely discloses a moisture curable sealant composition which comprises the product of reacting under anhydrous conditions a polysulfide of the formula



with a silane of the formula  $\text{Q}_n\text{SiX}_{4-n}$  where n is 1 or 2, Q is an organic groups which may be  $\text{CH}_2=\text{CR}_{15}-\text{C}_m\text{H}_{2m}-$ , and at least 2 X are organic hydrolyzable groups and the remaining X (if any) is  $\text{C}_{1-6}$  alkyl or chloroalkyl [abstract]. When the Q group in the silane is of formula  $\text{CH}_2=\text{CH}(\text{CH}_2)_m$  e.g. as in vinyl triethoxysilane or vinyl ethyldimethoxy (or diethoxy) silane, 3-10% of the SH groups of polysulphides of molecular weight 4,000-10,000 can be reacted by heating for 8-25 hr at 80-120°C with an amount of silane in the molar ratio to thiol in the polysulphide of 0.5 : 1 to 1.5 : 1. Addition of 0.001-3% by weight of catalyst e.g. an amine such as pyridine or sulphur enhances the amount of addition under otherwise identical conditions [column 6 lines 4-13]. In Example 14, for instance, Ely discloses a process wherein (B) 0.05mol of a polymer of the formula



was mixed with 500ml toluene and the mixture was boiled under reflux to remove water [column 17 lines 35-42] to achieve an inert environment and to this solution was added (D) 2.5g of sulfur (0.078mol) and (A) 0.17mol of vinylmethyldimethoxysilane [column 17 lines 42-45]. If pyridine was added as a catalyst as well, it would be included in an amount of 0.001-3% by weight of the composition which corresponds to 0.05 to 15.8 g or pyridine equal to 0.00067 to 0.2mol pyridine.

3. Ely does not disclose a process wherein both a nitrogen containing base and sulfur are mixed with claimed components (A) and (B). However, Ely does disclose that both pyridine (a nitrogen containing organic base) and sulfur may be used as catalysts for the reaction of (A) and (B) [column 6 lines 12-13].

4. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have prepared a silicon containing polysulfide type polymer by the process of mixing a vinyl silane, mercapto terminated polysulfide, nitrogen containing organic base and elemental sulfur because Ely teaches that it is within the skill of the art to prepare a silicon containing polysulfide type polymer by the process of mixing a vinyl silane, mercapto terminated polysulfide and Ely also teaches that it is within the skill of the art to catalyze the reaction with pyridine or elemental sulfur. One would have found it obvious to use both elemental sulfur and pyridine as the catalyst because Ely teaches that they are functional equivalents for this purpose and it is *prima facie* obvious to combine two composition each of which is taught by the prior art to be

useful for the same purpose, in order to form a third composition to be used for the very same purpose. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA). Absent any evidence to the contrary, there would have been a reasonable expectation of success in mixing a vinyl silane, mercapto terminated polysulfide, nitrogen containing organic base and elemental sulfur.

5. Regarding claim 9, Examiner has calculated the claimed mole percents of Example 14 of Ely that are required by claim 9 and found that (B) is used in an amount of 29.4 mol% of (A), (C) is used in an amount of 0.4 to 117 mol % of (A), and (D) is used in an amount of 3.1 mol % of  $(S_yR^3)$  repeating units in (B). The disclosed range of mol% of (C) overlaps the claimed range of 0.01 to 10 mol%. In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior *a prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 1911 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US 4,096,131) in view of Ely (US 3,925,331).

7. In Example 9, Price et al disclose a process of forming a silyl containing polysulfide polymer by mixing (B) a polysulfide of the formula [column 13 line 1]



with (D) 25 g of sulphur and (A) 150 g of methylvinyl dimethoxysilane under an atmosphere of nitrogen and vacuum at 100°C [column 15 lines 39-45].

8. Price et al do not disclose a process wherein a nitrogen containing organic base is mixed with components (A), (B) and (D).

9. Ely, discussed above, discloses that both pyridine (a nitrogen containing organic base) and sulfur may be used as catalysts for the reaction of (A) and (B) [column 6 lines 12-13]. Ely teaches, henceforth, that pyridine and sulfur are functionally equivalent for the purpose of catalyzing the reaction of (A) and (B). Ely also teaches that pyridine and sulfur should be included in 0.001 to 3% by weight [column 6 lines 12-13].

10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have prepared a silicon containing polysulfide type polymer by the process of mixing a vinyl silane, mercapto terminated polysulfide, nitrogen containing organic base and elemental sulfur because Price et al teach that it is within the skill of the art to prepare a silicon containing polysulfide type polymer by the process of mixing a vinyl silane, mercapto terminated polysulfide and sulfur and Ely teaches that it is within the skill of the art to catalyze the reaction of a vinyl silane and a mercapto terminated polysulfide polymer with pyridine or elemental sulfur. One would have been motivated to use both elemental sulfur and pyridine as the catalyst in the process of Price et al because Ely teaches that they are functional equivalents for this purpose and it is *prima facie* obvious to combine two composition each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069,

1072 (CCPA). Absent any evidence to the contrary, there would have been a reasonable expectation of success in mixing a vinyl silane, mercapto terminated polysulfide, nitrogen containing organic base and elemental sulfur.

11. Regarding claim 9, Examiner has calculated the claimed mole percents of Example 9 of Price et al that are required by claim 9 and found that (B) is used in an amount of 110 mol% of (A), (C) is used in an amount of 0.06 to 190 mol % of (A) (calculated based on the weight range of pyridine disclosed in Ely, discussed in paragraph 22), and (D) is used in an amount of 2.7 mol % of (S<sub>y</sub>R<sup>3</sup>) repeating units in (B). The disclosed range of mol% of (C) overlaps the claimed range of 0.01 to 10 mol%. In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 1911 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

### ***Response to Arguments***

12. Applicant's arguments, see pages of 8-14 of Applicants' arguments and paragraphs 9-17 of the submitted Declaration, filed 07/07/2009, with respect to Millen (US 3,476,826) have been fully considered and are persuasive. The rejection of 04/07/2009 has been withdrawn.

13. Applicant's arguments filed 07/07/2009 with respect to Ely (US 3,925,331) have been fully considered but they are not persuasive.

14. Applicants argue, see pages of 14-18 of Applicants' arguments and paragraphs 18-27 of the submitted Declaration, that the prior art only discloses a process with an organic amine or sulfur, not both. Applicants argue that there is not reason to combine the organic amine and sulfur into one process mixture. This argument is not convincing. Case law holds that it is *prima facie* obvious to combine two composition each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA). The obviousness rejection, however, could be overcome by a convincing showing of unexpected results to the combination of the organic amine and sulfur.

15. Applicants also argue that the results of combining the amine and sulfur of the prior art would be unpredictable and that there is no reason whatsoever in the prior art to expect the excellent properties obtained by utilizing both an organic base and sulfur. Applicants argue that there are unexpected results as exemplified by Comparative Examples 1 and 2 relative to Examples 1-3 of the subject Application. This argument is not convincing. Applicants do not state what the unexpected "excellent properties" are. Furthermore, Comparative Examples 1 and 2 simply state that "the reaction did not occur". However, the reactions of Comparative Examples 1 and 2 work in the prior art.

16. Any showing of unexpected results must meet three criteria: 1) the experimental data must compare the claimed invention to the analogous invention of the prior art, 2) the showing must be commensurate in scope with the present claims, and 3) the results must be, in fact, unexpected.



17. Regarding criterion 1), the processes of Comparative Examples 1 and 2 are not according to the prior art. The examples are carried out at 65°C whereas Ely requires a reaction temperature of 80-120°C and Price exemplifies a reaction temperature of 100°C. It is not a fair comparison to compare the prior art to the present invention at reaction temperatures not taught by the prior art. However, if Applicant can show that the combination of sulfur and an organic amine unexpectedly broadens the range of suitable reaction temperatures, this *may* be able to overcome the rejection so long as the aforementioned criteria are met. Furthermore, Applicants have not tested compositions containing pyridine, the amine of the prior art.

18. Regarding criterion 2), the data set presented in the present specification is not commensurate in scope with the claims. The independent claim 1 limits the component (A) to any compound containing an aliphatic unsaturated bond while only trimethoxysilanes have been used in the Examples; Applicants should show a broader range of silanes and especially trialkane silanes. Similarly, component (B) is only limited to a polysulfide polymer with at least two mercapto groups while the Examples only show polysulfides based on alkylene thioether and alkylene ether repeating units; Applicants should at least show polyphenylene sulfides as these are commonly used polysulfide resins. Similarly, component (C) is limited to any organic base or ammonia; Applicants should show a broader range of organic bases and at least one ammonia compound. Similarly, claim 1 does not limit the reaction temperature, amounts of components and reaction times, all of which will have an effect on the reaction. Of course, Applicants may choose to amend the claims in order to narrow the scope of the

invention to those embodiments that have demonstrated unexpected results, Applicant is reminded that no new matter may be entered.

19. Regarding criterion 3), it is unclear whether the results are unexpected. The inventive Examples of the present specification each have a "yield" of higher than 96%. The Examiner does not know what Applicants mean by "yield". Is this just the weight percent of the theoretical yield of the entire composition? Or is this the percent of -SH groups on the polysulfide polymer (B) that reacted with the silane compound (A)? If it is the latter and Applicants attempt to show that their invention achieves a higher percentage of -SH groups reacted with the silane compound (B), Examiner would like to remind Applicants that both Ely and Price only attempt to react some of the -SH groups with a silane [see column 5 lines 26-28 of Ely and the abstract of Price]. Any comparative examples to show an unexpected increase in percent of reacted -SH groups due to the combination of organic amine and sulfur must be performed by Applicants and not just referenced in Ely or Price.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIKE DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/mmd/

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796